

REMARKS

This is a full and timely response to the non-final Office Action (“Action”) dated June 23, 2011. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

Claim Status:

Claim 28 was cancelled previously without prejudice or disclaimer. By the present paper, no claims have been amended, added, or cancelled. Thus, claims 1 – 27, and 29 - 36 are currently pending for further action.

Objection to the Drawings:

In the recent Office Action, the Examiner has objected to the drawings under 37 CFR 1.83(a). (Action p. 2). The Examiner quotes the first sentence of 37 CFR 1.83(a) which states that the drawings must show every features of the invention specified in the claims. (Action p. 2). However, the Examiner fails to take into account the next sentence which states: “However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box).” (37 CFR 1.83(a)).

While Applicant does not necessarily agree with Examiner’s objection to the drawing, Applicant has added Figs. 8-11 which include flowcharts illustrating the various features recited within the claims. These new figures and the corresponding text added to the specification track and are supported by the originally-filed claims and other portions of the originally-filed specification. No new matter has been added.

In light of this addition and the following reasons, each of the Examiner's objections to the drawings should be reconsidered and withdrawn.

The Examiner asserts that the drawings should illustrate "[a] data store (not just a rectangular box with a label data store) associated with a service requesting network device configured to store a pairing data that relates said service requesting network device and a service providing networked device." (Action p. 2). Applicant maintains that a rectangular box with the label data store is sufficient for purposes of 37 CFR 1.83(a). It is unclear as to why a more detailed description of the data store is necessary. A more detailed illustration of a data store is simply not "essential for a proper understanding of the invention." (37 CFR 1.83(a)). Therefore the drawing, which is in the form of a "graphical drawing symbol or a labeled representation" is completely appropriate. The various functions of the data store are illustrated in the new figures.

The Examiner asserts that the drawings should illustrate "a logic (not just a rectangular box with a label logic) associated with said service requesting networked device configured to, in response to said service requesting device sending a service request to said service providing networked device, determine whether the pairing data should be updated and to update the pairing data if said pairing data is not valid." (Action, p.2). Again, Applicant maintains that a more detailed illustration is unnecessary. A precise illustration of the hardware and software that makes up the logic is not essential for an understanding of the invention.

The Examiner asserts that the drawings should illustrate that the data store comprises one or more of a file, memory and a register. (Action, p. 2). Furthermore, the Examiner asserts that the drawings fail to illustrate that the data store comprises an extensible markup language file. Each of these components is a type of data store. The data store itself, is

illustrated in Fig. 1. Thus, the file, memory, register, and XML file are illustrated as the general term “data store.”

The Examiner also asserts that the drawings fail to illustrate an IP address, a unique hardware identifier, a unique software identifier, a virtual identifier, and a dynamic identifier. (Action, p. 2). Each of these objects is illustrated generally as pairing data. The pairing data is illustrated in at least Fig. 4. Furthermore, the Examiner asserts that the drawings fail to illustrate the type of hardware identifiers. Specifically, a MAC address, a globally unique identifier, an object identifier, and an IP address. Again, each of these objects is illustrated generally as pairing data.

The Examiner asserts that the drawings fail to illustrate types of service requesting devices and service providing devices. Specifically, the Examiner asserts that the drawings fail to illustrate a computer, printer, scanner, and a server. Again, each of these devices is illustrated generally as either a service requesting device or a service providing device in Fig. 3. 37 CFR 1.83(a) does not require that specific types of generally illustrated objects be illustrated individually.

The Examiner asserts that the drawings fail to illustrate binding data that comprises one or more of a MAC address, a GUID, an OID, an IP address, and a virtual name. (Action, p. 3). However, the binding data is illustrated in Fig. 4. Again, 37 CFR 1.83(a) does not require that specific types of generally illustrated objects be illustrated individually.

35 U.S.C. § 112:

In the recent Office Action, the Examiner rejected Claims 1-27 and 29-36 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which applicant regards as the invention. (Action, p. 5)

For at least the following reasons, this rejection should be reconsidered and withdrawn.

Initially, the Applicant notes that, according to the MPEP, “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.” MPEP § 2173.02. According to the MPEP, “[i]f upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph, is appropriate, such a rejection should be made and *an analysis as to why the phrase(s) used in the claim is ‘vague and indefinite’ should be included in the Office action.*” MPEP § 2173.02 (emphasis added). For at least the following reasons, the rejections under 35 U.S.C. § 112, second paragraph should be reconsidered and withdrawn.

Regarding claim 1, the Examiner first asserts that “it is unclear what kind of “pairing data” is and it is unclear how a data store associates with a service requesting network device and configured to store a pairing data.” (Action, p. 5). The Applicant strongly disagrees with this rejection. The absence of a definition as to “what kind” of data the pairing data is does not render the claim indefinite under 112, second paragraph. Furthermore, the meaning of the term “data store” is defined explicitly in the specification at paragraph [0018]. It is clear and definite from the claim language that the data store is some type of memory that is able to be accessed by the networking device. Thus, not specifying exactly how the data store associates with the service requesting networked device does not render the claim indefinite under § 112, second paragraph. The Examiner appears to be incorrectly using § 112 for issues which the Examiner should be rejecting under § 102 or § 103 if any applicable prior art can be found.

The Examiner further asserts that “[i]t is unclear what kind of “logic” that applicant is talking and it is unclear how this logic associates with said service requesting networked device configured to determine whether the pairing data should be updated and to update the pairing data if said pairing data is not valid.” (Action p. 5). Again, Applicant strongly disagrees with this rejection. The absence of a narrower definition as to “what kind” of logic does not render the claim indefinite under 112, second paragraph. The term “logic” is explicitly defined in paragraph [0019]. Furthermore, not specifying what constitutes determining whether the pairing data should be updated does not make the claim indefinite. It is still clear that the process of determining whether it should or should not be updated is occurring. Additionally, not specifying what constitutes the pairing data being valid does not render the claim indefinite. It is completely definite to claim updating the pairing data if it is not valid. Either it is valid or it is not. Again, the Examiner appears to be incorrectly using § 112 for issues which the Examiner should be rejecting under § 102 or § 103 if any applicable prior art can be found.

Regarding claim 2, the Examiner asserts that “it is unclear how a register can store the pairing data.” (Action, p. 5). It is entirely unclear to Applicant why the Examiner believes such a claim is indefinite. Simply because the data store, which stores pairing data, includes a particular component (i.e. a register), does not mean that that component has to be able to store the pairing data itself. Even if the register is the entire data store, a register is a temporary and readily available piece of memory used by a processor. Thus, it would be completely capable of storing pairing data. Not specifying exactly how a register would store data has nothing to do with a rejection under § 112, second paragraph.

Regarding claim 4, the Examiner asserts that “it is unclear what kind of virtual identifier, and a dynamic identifier that the applicant is talking about.” (Action, p. 5). The

Examiner is respectfully reminded that during examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed Cir. 2004) (citations omitted). Thus, the terms “virtual identifier” and “dynamic identifier” should be given a meaning as would be understood by one of ordinary skill in the art. Again, the Examiner appears to be incorrectly using § 112 for issues which the Examiner should be rejecting under § 102 or § 103 if any applicable prior art can be found.

Regarding claims 7 and 8, the Examiner asserts that “it is unclear what kind of “logic” that can be configured” to perform various claimed features. (Action, p. 5). Again, the meaning of the term “logic” is explicitly defined in paragraph [0019]. Thus, logic clearly refers to software, hardware, or a combination of both capable of performing particular functions. Not specifying the exact type of logic does not make the claim indefinite under § 112, second paragraph.

Regarding claim 9, the Examiner asserts that “it is unclear what kind of a virtual name applicant is talking about.” (Action, p.5). Again, the Examiner is incorrectly rejecting a claim using § 112 rather than § 102 or § 103. Not specifying what kind of virtual name does not render the claim indefinite under § 112, second paragraph.

Regarding claims 10 – 12, the Examiner asserts that “it contains similar problems as in claims 1-8.” However, as mentioned above, the Examiner is required to provide “*an analysis as to why the phrase(s) used in the claim is ‘vague and indefinite’ should be included in the Office action.*” MPEP § 2173.02 (emphasis added). Claims 10-12 include different features from those of claims 1 – 8. Thus, the Examiner should provide a specific rejection as to what terms or phrases are “vague and indefinite”.

Regarding claim 13, the Examiner asserts that “it is unclear what exactly, is “a binding data that facilitates uniquely identifying a networked device.” (Action, p. 5). However, the meaning of the term “binding data” is defined right in the claim. Claim 13 recites “selectively requesting from one or more networked devices a binding data that facilitates uniquely identifying a networked device...” There is nothing vague or indefinite about this feature. Binding data is explicitly defined in the claim as being data “that facilitates uniquely identifying a networked device.” This clearly refers to any data that uniquely identifies a device. Again, the Examiner is incorrectly using § 112, second paragraph for issues that the Examiner should be using § 102 or § 103 if applicable prior art can be found.

Although the Examiner rejects claims 1-27 and 29-36 under 35 U.S.C. § 112, second paragraph, the Examiner only specifically mentions issues for the above referenced claims. As mentioned above, the Examiner is required to provide “*an analysis as to why the phrase(s) used in the claim is ‘vague and indefinite’ should be included in the Office action.*” MPEP § 2173.02 (emphasis added). The remaining claims include different features from the claims referenced above. If the Examiner is to make such a rejection of all claims, the Examiner should provide a specific rejection as to what terms or phrases are “vague and indefinite” within each claim.

35 U.S.C. § 102:

1. Claims 1-27, and 29-36 were rejected under 35 USC 102(a) as being anticipated by US Pat. No. 6,636,499 (hereinafter “Dowling”). For at least the following reasons, these rejections should be reconsidered and withdrawn.

Claim 1

Claim 1 recites:

A client-side auto-rediscovery system, comprising:
a data store associated with a service requesting networked device configured to store a pairing data that relates said service requesting networked device and a service providing networked device; and
a logic associated with said service requesting networked device configured to, *in response to said service requesting device sending a service request to said service providing networked device*, determine whether the pairing data should be updated and to update the pairing data if said pairing data is not valid.

(Emphasis added)

In the recent Office Action, the Examiner rejected claim 1 as being anticipated Dowling. (Action, p. 6). However, Dowling does not teach each and every element of claim 1. Specifically, Dowling does not teach “logic associated with said service requesting networked device configured to, *in response to said service requesting device sending a service request to said service providing networked device*, determine whether the pairing data should be updated.” (Claim 1) (emphasis added).

Dowling teaches a method for “automatic discovery of switches or other network devices on a LAN that are capable and ready to become part of a cluster.” (Dowling, col. Lines 54-56). However, Dowling does not teach or suggest a system that “*in response to said service requesting device sending a service request to said service providing networked device*, determine whether the pairing data should be updated.” (Claim 1) (Emphasis added).

Applicant teaches and claims a system wherein the process of determining whether pairing data should be updated is initiated by the service requesting device sending a service request.

However, Dowling does not teach or suggest this feature. Any teaching of initiating a discovery process in response to the service requesting device sending out a service request is entirely absent from the teachings of Dowling. Consequently, the rejection of claim 1 should be reconsidered and withdrawn.

Respectfully, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown in as complete detail as contained in the ... claim.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Consequently, because Dowling clearly fails to satisfy the requirements for anticipating claim 1, the rejection of claim 1 should be reconsidered and withdrawn.

Additionally, various dependent claims of the application recite subject matter that is further patentable over the cited prior art. Specific, non-exclusive examples follow.

Claim 7

Claim 7, as currently amended, recites “wherein to determine whether to update said pairing data the logic is further configured to generate a uni-cast simple network management protocol (SNMP) GET message to be delivered from the service requesting networked device to the service providing networked device and to compare data within a response to said GET message with said pairing data.”

The examiner has asserted that Dowling teaches the features of claim 7 by citing to Dowling, col. 8 lines 36-59. Here, Dowling teaches use of SNMP message but makes no mention or suggestion of *uni-cast* SNMP messages. Furthermore, Dowling does not teach the feature that the logic “compare[s] data within a respond to said GET message with said

pairing data.” Thus, Dowling clearly does not teach each and every feature of claim 7.

Consequently, the rejection of claim 7 should be reconsidered and withdrawn.

Claim 12

Claim 12 recites:

A client-side auto-rediscovery system, comprising:
means for storing a pairing data that relates a service requesting networked device and a service providing networked device;
means for performing a uni-cast based discovery between the service requesting networked device and the service providing networked device in response to a service request made from the service requesting networked device to the service providing networked device; and
means for selectively performing automatic multicast based discovery to rediscover the service providing networked device based on the uni-cast based discovery and selectively updating the pairing data based on the multicast based discovery.

(Emphasis added)

In the recent Office Action, the Examiner rejected Claim 12 as being anticipated by Dowling. (Action, p. 7). However, Dowling does not teach each and every element of claim 12. Specifically, Dowling does not teach performing a unicast based discovery “*in response to a service request made from the service requesting networked device to the service providing networked device, determine whether the pairing data should be updated.*” (Claim 12) (emphasis added).

Again, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown in as complete detail as contained in the ... claim.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim

within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Consequently, because Dowling clearly fails to satisfy the requirements for anticipating claim 12, the rejection of claim 12 should be reconsidered and withdrawn.

Claim 13

Claim 13 recites:

A client-side auto-rediscovery method, comprising:
 determining whether a service request from a first networked device to a second networked device has been made; and
 in response to a service request being made, performing a process that facilitates relating the first networked device and the second networked device by:
 selectively requesting from one or more networked devices a binding data that facilitates uniquely identifying a networked device;
 receiving, in response to requesting the binding data, a message that includes the binding data; and
 selectively updating a pairing data that relates the first networked device and the second networked device based, at least in part, on the binding data.
(Emphasis added)

In the recent Office Action, the Examiner rejected Claim 13 as being anticipated by Dowling. (Action, p. 7). However, Dowling does not teach each and every element of claim 13. Claim 13 recites subject matter similar to that of claim 1. Therefore, the arguments given above in favor of the patentability of claim 1 apply to claim 13. Specifically, Dowling does not teach the step of “*determining whether a service request from a first networked device to a second networked device has been made*” and performing a process “*in response to a service request being made*.” (Claim 13) (emphasis added).

Again, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown in as complete detail as contained in the ...

claim.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Consequently, because Dowling clearly fails to satisfy the requirements for anticipating claim 13, the rejection of claim 13 should be reconsidered and withdrawn.

Claim 26

Claim 26 recites:

A computer-readable medium providing processor executable instructions operable to perform a client-side auto-rediscovery method, the method comprising:
in response to determining that a service request has been made by a service requesting device;

with the service requesting device, selectively requesting from one or more networked devices a binding data that facilitates uniquely identifying a networked device;

with the service requesting device, receiving, in response to requesting the binding data, a message that includes the binding data;

with the service requesting device, selectively updating a pairing data that relates the first networked device and, the second networked device based, at least in part, on the binding data; and

with the service requesting device, storing the pairing data in a computer memory.

(Emphasis added)

In the recent Office Action, the Examiner rejected Claim 26 as being anticipated by Dowling. (Action, p. 7). However, Dowling does not teach each and every element of claim 26. Claim 26 recites subject matter similar to that of claim 1. Therefore, the arguments given above in favor of the patentability of claim 1 apply to claim 26. Specifically, Dowling does

not teach that the process is performed “*in response* to determining that a service request has been made by a service requesting device” (Claim 26) (emphasis added).

Again, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown in as complete detail as contained in the ... claim.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Consequently, because Dowling clearly fails to satisfy the requirements for anticipating claim 26, the rejection of claim 26 should be reconsidered and withdrawn.

Claim 31

A client-side auto-rediscovery method, comprising:
 discovering a first connection to a service providing networked device;
 client-side associating a stored connection between a service requesting networked device and the service providing networked device based, at least in part, on the first connection;
 upon *the service requesting networked device making a request for a service from the service providing networked device*, validating the stored connection;
 selectively re-discovering a second connection to the service providing networked device; and
 selectively client-side re-associating the stored connection based, at least in part, on the second connection.
 (Emphasis added).

In the recent Office Action, the Examiner rejected Claim 13 as being anticipated by Dowling. (Action, p. 7). However, Dowling does not teach each and every element of claim

13. Claim 13 recites subject matter similar to that of claim 1. Specifically, Dowling does not teach that “upon the service requesting networked device making a request for a service from the service providing networked device.” (Claim 31) (emphasis added). Thus, the rejection of claim 31 should be reconsidered and withdrawn.

Again, to anticipate a claim, a reference must teach each and every element of the claim, and “the identical invention must be shown in as complete detail as contained in the ... claim.” MPEP 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989) (emphasis added). Moreover, “[t]he prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *NetMoneyIn v. Verisign*, (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 (Fed. Cir. 1983)). Consequently, because Dowling clearly fails to satisfy the requirements for anticipating claim 31, the rejection of claim 31 should be reconsidered and withdrawn.

Conclusion:

In view of the preceding arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments in future papers supporting the patentability of any of the claims, including the separate patentability of the dependent claims not explicitly addressed herein. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

The absence of a reply to a specific rejection, issue or comment in the Office Action does not signify agreement with or concession of that rejection, issue or comment. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Further, for any instances in which the Examiner may wish to take Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2) and MPEP § 2144.03.

If the Examiner has any comments or suggestions which could place this application in better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

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Respectfully submitted,

DATE: 23 September 2011

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